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5

Application Number 10/625,756

Filing Date July 22, 2003

First Named Inventor Allan Joseph Kotwicki

Art Unit 3744

Examiner Name Harry Tanner

Attorney Docket Number 81091799

ENCLOSURES (Check all that apply)

- Fee Transmittal Form
 Fee Attached
 Amendment/Reply
 After Final
 Affidavits/declaration(s)
 Extension of Time Request
 Express Abandonment Request
 Information Disclosure Statement
 Certified Copy of Priority Document(s)
 Reply to Missing Parts/ Incomplete Application
 Reply to Missing Parts under 37 CFR 1.52 or 1.53

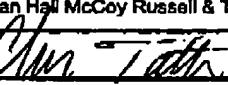
- Drawing(s)
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Remarks

- After Allowance Communication to TC
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 Proprietary Information
 Status Letter
 Other Enclosure(s) (please identify below):
- Response to Restriction Requirement

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name Alleman Hall McCoy Russell & Tuttle LLP

Signature 

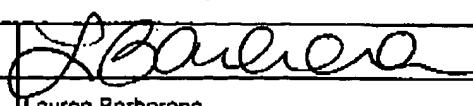
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JUL 28 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

July 28, 2005

ALLAN JOSEPH KOTWICKI, GEORGE BLAHA, GERHARD A. DAGE,
 JOHN DAVID RUSSELL and MICHAEL JOHN CULLEN

Serial No.	:	10/625,756	Group Art Unit: 3744
Filed	:	July 22, 2003	Examiner: Harry Tanner
For	:	CONTROL METHOD FOR A VEHICLE HAVING AN ENGINE AND AN ACCESSORY DEVICE	

Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the restriction requirement of June 29, 2005, applicant hereby elects Group I, claims 1-5, with traverse. Applicants' reasons for traverse and request for reconsideration is set forth below.

The June 29, 2005 restriction requirement indicates that restriction is required between Group I (claims 1-5) and Group II (claims 8-11) because the groups disclose distinct inventions as shown by their separate utility. Without commenting on whether or not distinct inventions are claimed, applicants respectfully submit that the examiner's basis for restriction relies on assertions that are incorrect.

The restriction requirement categorizes claims 1-5 (Group I) as being drawn to a compressor control responsive to a speed ratio of a torque converter, classified in Class 62, subclass 133. The restriction requirement further categorizes claims 8-11 (Group II) as being drawn to a compressor control responsive to the time of the operation of the compressor, classified in Class 62, subclass 157. In support of the argument that the two groups have separate utility, the examiner states that

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Group I has utility "in a system that does *not* have the indication of when the compressor has been disengaged greater than a predetermined value." (Emphasis added.) However, claim 2, which is in Group I, includes the limitation "...engaging the device based at least on said operating condition *when the device is disengaged greater than a predetermined duration...*" Thus, claim 2 includes the very limitation that the restriction requirement identified as the basis for distinguishing Groups I and II. Therefore, the rationale identified by the examiner for restricting examination is not supported by the language of the claims.

Moreover, even if it is appropriate to restrict Groups I and II for the reasons identified in the restriction requirement, restriction is only proper when a search and examination of an entire application places a serious burden on the examiner. MPEP § 803. See also MPEP § 811, "Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." Applicants respectfully submit that there is no serious burden in this case for at least the following reasons:

First, the limitations of the claims are so closely interrelated that the examiner will have to conduct a search encompassing both of the indicated subclasses even if the restriction requirement is maintained. As stated above, limitations that define Group II are present in claims included in Group I. Thus, even if the basis for restriction is proper, the examiner will have to search the prior art for the same limitations defining the second group when examining claims in the first group. Therefore, no serious burden exists.

Second, the examiner has already performed a search encompassing claims 1-5 and 8-11. An Office action dated January 6, 2005 was issued rejecting claims 1-5 and 8-11 over prior art. While applicants have amended claim 1 in response to the January 6, 2005 Office action (see Amendment dated April 4, 2005), applicants submit that such amendment was not so significant as to alter the search parameters for claims 1-5. Specifically, original claim 1 and amended claim 1 are both drawn

to a compressor control responsive to a speed ratio of a torque converter. Applicants note that claims 2-5 and 8-11 remain as originally filed. Applicants respectfully submit that since a search encompassing claims 1-5 and 8-11 has already been performed, no serious burden to the examiner can exist in continuing to examine these claims in the same application.

Third, the issuance of a restriction requirement contradicts the rejection of all claims over the same prior art. In the Office action dated January 6, 2005, all claims were rejected based upon the same prior art. Specifically, claims 1 and 2 were rejected as being anticipated by Lizuka et al, and claims 3-5 and 8-11 were rejected as being unpatentable over Lizuka et al *as applied to claim 1* and further in view of additional art and/or official notice. Thus, the same disclosure in the Lizuka reference was used in the same manner in order to reject all of the claims. However, by issuing a restriction requirement, the examiner has asserted that the claims define patentably independent or distinct groups of inventions. Without commenting on whether the claims define patentably independent or distinct groups of inventions, applicants submit that the assertion that the claims define patentably distinct groups of inventions contradicts the rejection of all claims based upon the same prior art.

Fourth, the issuance of a second restriction requirement after prosecution on the merits has begun is an unfair burden on Applicants in this instance. In a September 29, 2004 restriction requirement, the examiner issued a restriction requirement wherein claims 1-5 and 8-11 were placed in the same group and identified as belonging to subclass 230. Applicants elected claims 1-5 and 8-11 in good faith, believing such election would expedite prosecution of the application. Moreover, as indicated above, an Office action directed towards claims 1-5 and 8-11 was issued after receipt of applicants' election. Applicants understand that an examiner can make a restriction requirement at any time before final action. However, as stated above, claims 2-5 and 8-11 remain in their original form and the amendment to claim 1 did not alter the classification or scope of search required for

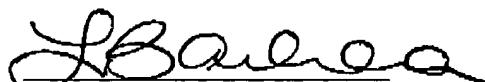
prosecution on the merits of the claim. Thus, applicants respectfully submit that in this case, had the examiner believed that claims 1-5 and 8-11 should have been restricted, an appropriate restriction should have been made in the September 29, 2004 restriction requirement or at least before issuance of the Office action.

Based on the foregoing comments, applicants respectfully request reconsideration of the restriction requirement. The above-identified application is believed to be in condition for allowance, and such allowance is courteously solicited. If any further amendment is necessary to advance prosecution and place this case in allowable condition, the Examiner is courteously requested to contact the undersigned by fax or telephone at the number listed below.

Please charge any cost incurred in the filing of this Amendment, along with any other costs, to Deposit Account No. 06-1510. If there are insufficient funds in this account, please charge the fees to Deposit Account No. 06-1505. A duplicate copy of this sheet is enclosed.

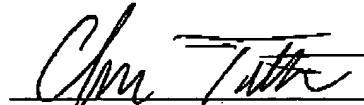
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Lauren Barberena

Respectfully submitted,

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